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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,890	01/07/2004	Richard H. Bossi	038190/269130	4562

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EXAMINER	
CHAPMAN JR, JOHN E	

ART UNIT	PAPER NUMBER
2856	

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/752,890	BOSSI ET AL.	
	Examiner	Art Unit	
	John E. Chapman	2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,10-12,20,23 and 24* is/are rejected.

7)☒ Claim(s) *2-9,13-19,21 and 22* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 12 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Kennedy et al. discloses a driven probe (actuating portion) 14 having at least one magnet 18, and a tracking probe (inspecting portion) 16 having an inspection sensor 20 and at least one magnet 18.

Regarding claim 12, the inspection sensor may comprise a camera (column 6, line 67).

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being obvious over Kennedy et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37

CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The only difference between the claimed invention and the prior art consists in the type of the ultrasonic transducer employed. It is well known in the art to use a laser ultrasonic transducer in order to provide a non-contact arrangement and avoid having to provide a coupling medium. Accordingly, it would have been obvious to one of ordinary skill in the art to use a laser ultrasonic transducer in the inspection device of Kennedy et al. in order to provide a non-contact arrangement and avoid having to provide a coupling medium.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being obvious over Kennedy et al. in view of Clark et al.

The only difference between the claimed invention and the prior art consists in providing a positional encoder to monitor the positioning of the probe. Kennedy et al. teach recording the relative position of the tracking probe (column 9, lines 56-60). It is well known in the art to provide a position encoder in order to monitor the position of a probe, as taught by encoder 92 of Clark et al. Accordingly, it would have been obvious to one of ordinary skill in the art to provide the probe 14 of Kennedy et al. with a positional encoder in order to monitor the relative position of the probes on the surface of a structure 12.

5. Claim 23 and 24 are rejected under 35 U.S.C. 103(a) as being obvious over Kennedy et al. in view of Bashyam.

The only difference between the claimed invention and the prior art consists in the inspecting a feature of the structure extending from the second surface of the structure. It is well known in the art to inspect a complex surface, such as a flange inner fillet 28 in Fig. 3 of Bashyam. Accordingly, it would have been obvious to one of ordinary skill in the art to provide the tracking probe 16 of Kennedy et al. with an ultrasonic transducer for inspecting a complex surface, such as a flange inner fillet 28 in Fig. 3 of Bashyam.

6. Claims 1, 11, 12 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-17 and 29 of U.S. Patent No. 6,722,202 ('202). Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between claim 1 and claim 15 of '202 consists in providing the sensing element on the tracking probe (inspecting portion), which is one

of the alternatives provided in claim 15, lines 17-20. Note that the actuating portion is "structured for placement on a surface of a structure" (claim 1, line 4), so that it inherently comprises a "contact member for contacting the first surface of the structure" (claim 15, line 4).

Regarding claim 11, the only difference between the claimed invention and claim 17 of '202 consists in the type of the ultrasonic transducer employed. It would have been obvious to one of ordinary skill in the art to use a laser ultrasonic transducer in the inspection device of '202 in order to provide a non-contact arrangement and avoid having to provide a coupling medium.

Regarding claim 12, claim 16 or '202 recites a camera.

Regarding claim 20, the only difference between claim 1 and claim 29 of '202 consists in receiving ultrasonic signals with the tracking probe (i.e., providing an inspection sensor on the inspecting portion), which is one of the alternatives provided.

7. Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of '202 in view of Clark et al. The only difference between the claimed invention and claim 15 of '202 consists in providing a positional encoder to monitor the positioning of the probe, which would have been obvious in view of encoder 92 of Clark et al.

8. Claims 23 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of '202 in view of Bashyam. The only difference between the claimed invention and the prior art consists in the inspecting a feature of the structure extending from the second surface of the structure. It is well known in the art to

inspect a complex surface, such as a flange inner fillet 28 in Fig. 3 of Bashyam. Accordingly, it would have been obvious to one of ordinary skill in the art to provide the tracking probe 16 of Kennedy et al. with an ultrasonic transducer for inspecting a complex surface, such as a flange inner fillet 28 in Fig. 3 of Bashyam.

9. Claims 2-9, 13-19, 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kennedy et al. (4,848,159) discloses an ultrasonic inspection probe for laminated structures comprising flange shoes 52 and 54 for inspecting a web 34 in Figs. 3B and 3C.

11. Applicant's arguments filed on June 21, 2005 have been fully considered but they are not persuasive. Applicant argues that the rejection of claims under 35 U.S.C. 102(e) and 103(a) based on U.S. Patent No. 6,722,202 to Kennedy et al. has been overcome by virtue of a claim for priority under 35 U.S.C. 120 to the Kennedy patent. However, a petition to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of priority to the non-provisional application that matured into the Kennedy patent has not been granted. Note the Decision on Petition mailed on August 22, 2005. Accordingly, the applicant has not complied with one or more conditions for receiving the benefit of the earlier filing date under 35 U.S.C. 120. Applicant further argues that the rejection of claims under the judicially created

doctrine of obviousness-type double patenting based on the Kennedy patent has been overcome by virtue of a claim for priority under 35 U.S.C. 120 to the Kennedy patent. It is noted that a claim for priority under 35 U.S.C. 120 to the Kennedy patent, even if granted, would not be effective to overcome the rejection of claims under the judicially created doctrine of obviousness-type double patenting. See MPEP 804.02, part VI.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John E. Chapman whose telephone number is (571) 272-2191. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron

Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John E Chapman
Primary Examiner
Art Unit 2856